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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,178	10/19/2001	Tai-Her Yang	YANG3080/EM/7317	7822

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EXAMINER

ESTREMSKY, SHERRY LYNN

ART UNIT	PAPER NUMBER
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3681

DATE MAILED: 05/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/982,178

Applicant(s)

YANG, TAI-HER

Examiner

Sherry L Estremsky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 65-73 and 75-141 is/are pending in the application.
- 4a) Of the above claim(s) 108-130 and 139-141 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 65-73, 75-88, 93-106, 131, 132, 134 and 138 is/are allowed.
- 6) ☒ Claim(s) 89, 90, 107, 133 and 135-137 is/are rejected.
- 7) ☒ Claim(s) 91 and 92 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

The receipt of the amendment dated December 18, 2003 and February 24, 2004 of the application 09/982,178, including amendments to the specification and claims, cancellation of claim 74, and addition of claims 131-141 is acknowledged.

Election/Restrictions

1. Claim 65 is generic and allowable. Accordingly, the restriction requirement as to the encompassed species is hereby withdrawn and claims 100-107, previously withdrawn as being directed to non-elected species, are no longer withdrawn from consideration since all of these claims depend from or otherwise include each of the limitations of an allowed generic claim. However, claims 108-130 remain withdrawn from consideration since they do not depend upon or otherwise include all the limitations of an allowed generic claim as required by 37 CFR 1.141.

In view of the above noted withdrawal of the restriction requirement as to the linked species, applicant(s) are advised that if any claim(s) depending from or including all the limitations of the allowable generic linking claim(s) be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

2. Claims 108-130 and 139-141 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 4.

Claim Objections

3. Claims 65 and 103 are objected to because of the following informalities: in line 15 of claim 65, "dynamo-electric device" should be --dynamo-electric unit-- to maintain a consistent use of terms, and in line 3 of claim 103, "and intermediate" should be --an intermediate--. Appropriate correction is required.

4. Claim 138 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 134. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. Note that in this instance, the two claims are identical. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 89-92, 107, 133, and 135-137 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 89 is indefinite because it incorrectly claims that the speed-controlled dynamo-electric compound system includes two transmission mechanisms for connecting the engine to the secondary dynamo-electric unit. One is claimed in lines 14-15, and a second is claimed in lines 21-23.

Claim 107 is indefinite in claiming "said first and second centrifugal clutches" because, although "at least one centrifugal clutch" in claim 65 allows for a second centrifugal clutch, no second centrifugal clutch was previously expressly claimed.

In claim 133, "said output clutch" is indefinite because it lacks antecedent basis.

In claim 135, 136, and 137, "said another clutch" is indefinite because it lacks antecedent basis. Claim 134 first claims "another clutch".

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 89 (interpreted to include only one "transmission mechanism") and 90 are rejected under 35 U.S.C. 102(b) as being anticipated by Field, U. S. Patent 6,044,922.

Field shows in figure 1 a speed-controlled dynamo-electric compound system.

Primary dynamo-electric unit 16 is arranged to rotate a shaft (from element 26 to element 14).

Centrifugal clutch 26 (column 6, lines 39-41) has a driven side connected to the shaft and a driving side connected to an engine 24 (column 6, lines 24-25, the "transfer case" being the interconnection of clutch 26 with the engine, the dynamo-electric unit 16, and the shaft). As

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explained below, rotation of the primary dynamo-electric unit at a preset speed causes the engagement of the centrifugal clutch 26.

A load (wheels 12) is connected to the shaft through an output device (a not shown transmission and differential 14).

Secondary dynamo-electric unit 28 is coupled to the engine 24.

Electrical energy storage device 18 is connected between the secondary dynamo-electric unit 28 and the primary dynamo-electric unit 16.

The system includes a controller 20.

Figure 1 shows a transmission mechanism for connecting the engine 24 to the second dynamo-electric unit 28.

Column 5, lines 46-54 teaches that when the primary dynamo-electric unit 16 is supplied with electricity from the energy storage device 18 to be caused to rotate at below a preset speed (as the vehicle is accelerated to a predetermined speed) the dynamo-electric unit drives the output device. When the primary dynamo-electric unit 16 is caused to rotate above the preset speed, the clutch 26 engages, thereby connecting the engine 24 to the primary dynamo-electric unit 16.

(claim 89)

The transmission mechanism connecting the engine 24 and the second dynamo-electric unit 28 is a fixed speed ratio transmission.

(claim 90)

Allowable Subject Matter

9. Claims 65-73, 75-88, 93-106, 131, 132, 134, and 138 are allowed.

10. Claims 91 and 92 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Claims 107, 133, and 135-137 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Response to Amendment

12. As stated by the applicant in the paper dated March 28, 2003, former claim 74 was generic, and therefore current claim 65, which was amended to include the subject matter of cancelled claim 74, remains generic. All of the claims dependent on claim 65 which were previously withdrawn from consideration have now been examined. Claims 65-73, 75-88, 91-107, and 131-138 have been found allowable over the prior art, and claims 108-130 and 139-141 have been withdrawn from consideration.

Applicant's arguments regarding claims 89 and 90, filed December 18, 2003, have been fully considered but they are not persuasive. The examiner agrees that Field shows the secondary dynamo-electric unit 28 directly connected to the engine 28 by a belt and pulley, but since the applicant stated that this is not a transmission mechanism without explaining why it is not, the examiner does not understand the applicant's position that this is not a transmission mechanism. It is the examiner's belief that belts and pulleys are mechanisms because they are components of machinery, and are transmission mechanisms because they transmit rotation from one place to another. It appears that the belt and pulleys constitute a fixed speed ratio transmission mechanism as disclosed and claimed.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sherry L Estremsky whose telephone number is (703) 308-2164. The examiner can normally be reached on Tuesday and Friday from 7:30 a.m. to 6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor can be reached on (703) 308-0830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 5-7-04
SHERRY ESTREMSKY
PRIMARY EXAMINER

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